REMARKS

Status of the Claims

Claims 1-6 and 11-15 are now present in this application. Claims 1 and 11-13 are independent.

Claims 1-4 and 11-15 have been amended. Reconsideration of this application, as amended, is respectfully requested.

Rejection Under 35 U.S.C. § 112, 2nd Paragraph

The Examiner has rejected claims 1-6, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. More specifically, the Examiner states, "it is unclear whether the claim element is a means (or step) plus function limitation that invokes 35 U.S.C. 112, sixth paragraph", because the claim does not clearly state means for. Although Applicant does not necessarily agree with the Examiner regarding this issue, claims 1-6 have been amended by deleting "means" rendering the rejection as moot.

Rejection Under 35 U.S.C. § 101

Claims 1, 7, and 21 are rejected under § 101 because the claimed invention is directed to non-statutory subject matter. Initially, it is understood that instead of claims 1, 7, and 21, claims 11-13 should have been recited therein because claim 1 does not recite "program" and claim 7 is canceled and there is no such claim numbered 21. Although Applicant does not necessarily agree with the Examiner regarding this non-statutory rejection of claims 11-13, these claims 1-6 have been amended through this reply to recite, *inter alia*, "a computer-readable storage medium" in order to expedite prosecution.

Rejections under 35 U.S.C. §103

A. Claims 1-3 and 11-13 stand rejected under 35 U.S.C. § 103 as being unpatentable over Iwase (U.S. Patent Publication No. 2002/0046247A1)[hereinafter "Iwase"] and Watanabe (U.S. Patent No. 6,877,031)[hereinafter "Watanabe"] in view of Aziz (U.S. Patent No. 5,604,803)[hereinafter "Aziz"]. Applicants respectfully traverse.

Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Additionally, there must be a reason why one of ordinary skill in the art would modify the reference or combine reference teachings to obtain the invention. A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int'l Co. v Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007). There must be a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. *Id.* The Supreme Court of the United States has recently held that the "teaching, suggestion, motivation test" is a valid test for obviousness, albeit one which cannot be too rigidly applied. *Id.* Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *Id.*

In this instance, it is respectfully submitted that none of Iwase, Watanabe, and Aziz, alone or in combination, teaches or suggests all claim limitations.

For example, independent claim 1 recites, *inter alia*, "a print user designation managing unit that creates, ***in response to the received electronic mail transmitted from said user, a user ID and a password and a directory for a mail address*** used by said user, and ***transmits said user ID and said password to said mail address***." (*Emphasis added.*) Independent claims 11-13 also recite similar features.

It is respectfully submitted that none of Iwase, Watanabe, and Aziz, alone or in combination, teaches or suggests the above-identified feature of independent claims 1 and 11-13.

First, the Examiner acknowledges that Iwase fails to teach or suggest, *inter alia*, "managing means which creates a user ID and a password and a directory for a mail address used by said user, and transmitting said user ID and said password to said mail address". Thus, the Examiner imports Watanabe to fulfill the above-noted deficiency of Iwase. (*See page 7, lines 1-*

3.) Watanabe *does not create* an ID and password, rather compares the user ID and password of a user with the user ID and password previously provided by the user which have been stored in a database. There is *no creation* of a user ID and password as required by the claimed invention. See for example, col. 7, lines 28-31 of Watanabe which discloses as follows:

> The WWW application server 15 **compares** the user ID and the user password having been input with a user ID and a user password **registered** with and managed by a user information **database** (not shown). When the user ID and the user password input by the user are valid, a main menu is shown on a screen. When the user selects an electronic mail transmission option from the main menu, the electronic mail transmission service which will be explained below is provided. (Emphasis added.)

As clearly started in Watanabe, there is *no creation* of a user ID and password as required by the claimed invention. Rather, mere comparison between user ID and password input by a user and stored user ID and password previously entered/registered by the user which is stored in a database.

Further, after the comparison, Watanabe does not transmit the user ID and password to the mail address. Rather, Watanabe discloses as follows:

> A user A (using a personal computer 6a) requests the center server 12 to transmit an electronic mail message to a user B (using a personal computer 6b) in this example. As shown in FIG. 3, information such as **an ID 23 of an image to be transmitted to the user B**, a comment 24, a destination address 25 (a mail address of the user B), and a sender's address 26 (a mail address of the user A) is provided from the user A to the service provider. Based on this information, the center server 12 generates an electronic mail message 29 which has the comment 24 as main text and an image file 27 indicated by **the image ID 23** in the low resolution image database 16 as an attachment document. The center server 12 sets the address 26 of the user A as the sender's address and transmits the electronic mail message to the user B at the destination address 25. In this embodiment, the image file 27 is assumed to be a file compressed according to the JPEG format. (Emphasis added) (See col. 7, lines 39-55.)

As demonstrated above, Watanabe discloses sending *an image ID 23*, *not user ID and password*, to another user (user B). In other words, user B receives an electronic mail indicating which image he/she can view (in this example, the image file identified in image ID 23). User B does need any user ID and password to view the image file identified in image ID 23.

Based on the foregoing, it is respectfully submitted that Watanabe fails to teach or suggest, *inter alia*, "a ___managing unit that creates a user ID and a password and a directory for a mail address used by said user, and transmits said user ID and said password to said mail address___" as recited in the claimed invention.

Further, the Examiner acknowledges that neither Iwase nor Watanabe teaches or suggest, *inter alia*, "in response to the received electronic mail transmitted from said user". Thus, the Examiner imports Aziz to fulfill the above-noted deficiency of Iwase and Watanabe. (*See page 8, lines 1-3.*)

It is respectfully submitted that Aziz fails to fulfill the above-noted deficiency of Iwase and Watanabe. Aziz merely teaches a conventional method and apparatus for user authentication in a network environment between a client computer ("workstation") and a remote destination server coupled to the network. In Aziz, no electronic mail is transmitted from client workstation to the destination server. Rather, a user by using the workstation and the network **enters** login information and a password as the e-mail address so that the destination server can verify for authentication. If verified, the destination server sends a Privacy Enhanced Mail (PEM) encrypted password to the user. (*See col. 2, lines 25-51.*) There is no disclosure in Aziz that the destination server receives an e-mail from the user. Aziz only teaches that the destination server sends an e-mail to the user. Thus, it is evident that Aziz fails to teach or suggest, *inter alia*, "___in response to the received electronic mail transmitted from said user___".

At least in view of the above, Applicants respectfully submit that the asserted combination of Iwase, Watanabe, and Aziz (assuming these references may be combined, which Applicants do not admit) fails to establish *prima facie* obviousness of independent claims 1 and 11-13 or any claim depending therefrom.

Therefore, Applicant respectfully requests the withdrawal of the rejection of claims 1-3 and 11-13 based on Iwase, Watanabe, and Aziz.

B. Claims 4-6, 14, and 15 (not claim 16 as stated by the Examiner) stand rejected under 35 U.S.C. § 103 as being unpatentable over Iwase and Watanabe in view of Aziz, and further in view of Fujii (U.S. Patent Publication No. 2002/0138313)[hereinafter "Fujii"]. This rejection is respectfully traversed.

Claims 4-6 depend on claim 1 and claims 14-15 depend on claim 13. As demonstrated above in great detail, none of Iwase, Watanabe, and Azziz, alone or in combination, teaches or suggests, *inter alia*, "a print user designation managing unit that creates, *in response to the received electronic mail transmitted from said user, a user ID and a password and a directory for a mail address* used by said user, and *transmits said user ID and said password to said mail address*." as recited in claims 1 and 13. Fujii has not been, and indeed cannot be, relied upon to fulfill the above-noted deficiency of Iwase, Watanabe, and Aziz.

Thus, at least for the same reasons stated with respect to claims 1 and 13, it is respectfully submitted that claims 4-6 and 14-15 are allowable over Iwase, Watanabe, Aziz, and Fujii.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Ali Imam, Registration No. 58755 at the telephone number of the undersigned below to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Director is hereby authorized in this, concurrent, and future replies to charge any fees required during the pendency of the above-identified application or credit any overpayment to Deposit Account No. 02-2448.

Dated: September 22, 2010   Respectfully submitted,

By   #58,755

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